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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CASEY WILLIAM NORMAN and
TORQUIL PATRICK ALEXANDER NORMAN

Appeal 2008-006325
Application 09/844,322
Technology Center 3700

Decided:¹ May 21, 2009

Before WILLIAM F. PATE, III, LINDA E. HORNER, and
KEN B. BARRETT, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Casey William Norman and Torquil Patrick Alexander Norman (Appellants) seek our review under 35 U.S.C. § 134 from a non-final rejection of claims 20-23, 25, 26, and 28-51.² We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

Appellants' claimed invention pertains to doll garments made from an elastomeric material. (Spec. 1, ll. 1-23.) According to Appellants, such garments are especially suitable for small dolls having articulated limbs. (*Id.*) Claims 21 and 38, reproduced below with paragraphing added, are representative of the subject matter on appeal.

21. A garment comprising
- a flexible and elastic injection molded thermoplastic elastomer doll's garment
- having a molded shape to fit over, in a life-like way, external surfaces of at least a portion of a doll that has articulated limbs,
- has a through hole that accommodates passage of a doll's head or limb(s) and

² During the prosecution of the present application, several office actions have been mailed and multiple appeal briefs have been filed. We refer, in this decision, to the Examiner's Answer mailed February 6, 2008 (Ans.) which responds to the Appeal Brief filed June 27, 2007 (App. Br.) submitted in response to the non-final rejection in the Office Action mailed August 17, 2006 (Non-Final Rej.).

a wall thickness from 1 to 3 mm.

38. A play set comprising, in cooperative combination,
a doll donned and fitted with a flexible and elastic
injection molded garment which is molded to be removed,
dressed and refitted again over external surfaces of the doll in a
life-like way,

the doll being articulated at a joint selected from the
group consisting of the joints of the shoulders, elbows, knees,
neck and hips,

the garment has a through hole that accommodates
passage of a doll's head or limb(s) and

being molded from an elastomeric material selected from
the group consisting of ethylene vinyl acetate copolymer,
styrene-butadiene-styrene, styrene-isoprene-styrene, styrene-
diene, styrene-isoprene-butylene block copolymers containing
mineral oil, branched styrene copolymer, styrene butadiene
rubber, styrene-butadiene triblock rubber, styrene-isoprene-
styrene linear block polymer, styrene-butadiene radial block
copolymer, butadiene-styrene copolymer rubber,

the garment having a wall thickness from 1 to 3 mm and
an average modulus of elasticity of less than 1 MN/m².

THE REJECTIONS

The Examiner relies upon the following as evidence of
unpatentability:

| | | |
|---------|-----------------|---------------|
| O'Brian | US 2,944,368 | July 12, 1960 |
| Wion | US 4,294,036 | Oct. 13, 1981 |
| Kramer | US 5,607,339 | Mar. 4, 1997 |
| Gross | US 5,913,708 | June 22, 1999 |
| Yasuda | US 5,928,803 | July 27, 1999 |
| Whitney | US 6,475,609 B1 | Nov. 5, 2002 |

The following rejections are before us for review:

1. Claims 20-23, 25-26, and 28-51 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite;
2. Claims 21-23, 25, 28, and 30-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gross and Kramer;
3. Claim 26 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Gross, Kramer, and Whitney;
4. Claims 20, 29, and 35-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gross, Kramer, and Yasuda;
5. Claims 38-51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gross, Kramer, and Yasuda;
6. Claims 21-23, 25, 28, and 30-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Brian, Kramer, and either Gross or Wion;
7. Claim 26 is rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Brian, Kramer, and either Gross or Wion, and further in view of Whitney;
8. Claims 20, 29, and 35-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Brian, Kramer, and either Gross or Wion, and further in view of Yasuda;
9. Claims 38-51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Brian, Kramer, Yasuda, and either Gross or Wion;
10. Claims 21-23, 25-26, 28, and 30-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kramer, O'Brian, and either Gross or Wion;

11. Claims 20, 29 and 35-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kramer, O'Brian, and either Gross or Wion, and further in view of Yasuda;

12. Claims 38-51 are rejected under 35 U.S.C. § 103 as being unpatentable over Kramer, O'Brian, Yasuda, and either Gross or Wion.

Appellants submit, in support of their arguments for patentability, the Declaration of Mr. Casey William Norman, a named-inventor on the application at issue.

ISSUES

The first issue on appeal concerns the recited claim phrase “in a life-like way.” The Examiner concluded that that phrase renders all of the claims on appeal indefinite because the scope of the subject matter encompassed by that phrase cannot be determined. (Ans. 3.) Appellants argue that one of ordinary skill in the art would understand that “in a life-like way” means that the garments are placed on the doll in the same manner as a human would don a corresponding piece of clothing. (App. Br. 7-8.) Thus, the first issue before us is whether Appellants have shown that the Examiner erred in concluding that one of ordinary skill would not understand the scope of the claimed subject matter when the claims are read in light of the Specification.

Also before us are several obviousness rejections applied to different groups of claims and based on various combinations of prior art references.

Appellants argue that the applied prior art lacks several features, and that one of ordinary skill in the art would not combine the references. (*See, e.g.*, App. Br. 9-15.) At the end of Appellants' Brief, they also argue that all of the Examiner's proposed combinations of prior art "rely on the notoriously tempting concept known as 'hindsight.'" (App. Br. 26.) Therefore, the issues concerning the obviousness rejections are whether the Appellants have shown that the Examiner erred in concluding that a rational reason (not based on impermissible hindsight) exists as to why one of ordinary skill in the art would have combined the references, and in concluding that the combined references would have rendered the claimed subject matter obvious. Additionally, since evidence regarding secondary considerations has been submitted, we must decide, using a balancing test, whether the evidence in totality points for or against obviousness.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence.

1. Gross discloses a doll having articulated limbs. (*See, e.g.*, Gross, Figs. 12, 13.) Gross also discloses an inflatable bodysuit or jumpsuit 180 having an inner layer 78*e* and an exterior skin portion 90*e*. (*Id.*, col. 16, l. 66 – col. 17, l. 8; figs. 18, 19.) "[T]he inner layer 78*e* ... may be made from a non-expansible thermoplastic material made from an impermeable elastic material and the exterior skin portion 90*e* may be made from an elastomeric, air-impermeable material such as rubber, or rubberized fabric." (*Id.*, col. 17, ll. 28-33.) The bodysuit or jumpsuit 180 fits over the doll and

has a through hole that accommodates passage of the doll's head. (*See id.*, fig. 18.)

2. The Examiner found that Gross discloses a flexible and elastic thermoplastic elastomer doll garment. (Non-Final Rej. 3 (discussing Rejection No. 2, and citing Gross, col. 17, ll. 1-36); Ans. 4.) Appellants do not dispute this finding as to the disclosed material. (*See App. Br.* 14-15 (discussing Gross in the context of Rejection No. 6); *id.* at 21-22 (addressing Rejection No. 2).)

3. Gross teaches a suit that has a molded shape to fit over external surfaces of a portion of the doll so as to have a realistic appearance. (*See* Gross, col. 18, ll. 20-25; figs. 18-22; *id.*, col. 17, ll. 37-39 (“The integral skin adds realism.”).) The jumpsuit design is “readily adaptable to a doll with movable limbs[.]” (*Id.*, col. 17, ll. 22-25; *see also id.*, figs. 20-31 (articulated doll wearing a jumpsuit).) Gross explains that the doll body “is simply inserted much as a human would enter a ski suit, jumpsuit, or other one piece garment.” (*Id.*, col. 18, ll. 38-40.)

4. The jumpsuit of Gross appears to be identical or substantially identical to the injection molded garment of Appellants' claim 21. (*Compare* Gross, Fig. 22 *with* Spec. Figs. 1a-1f.)

5. Kramer discloses a bath toy that is a doll formed from a flexible sheet of polymer plastic material. (Kramer, col. 1, ll. 4-5, 51-56.) Clothes formed from flexible sheet-form overlays of polymer plastic material between 2 mm and 6 mm in thickness are adhered to the doll via surface tension due to a thin layer of water trapped between the doll and the clothes. (*Id.*, col. 1, l. 63 – col. 2, l. 5.)

6. Kramer indicates that the selection of the material thickness is based upon several factors including the manual dexterity of the child playing with the toy and the level of abuse that the material can withstand without tearing. (Kramer, col. 3, l. 23 – col. 4, l. 11.)

7. Kramer states that the material must be flexible so that it may adhere to surfaces with a curvature, such as the sidewall of a bathtub. (Kramer, col. 3, ll. 10-13.) Kramer explains that sheet material having a modulus of elasticity of less than 750 pounds per square inch should be used; otherwise the material will spring away from and not adhere to a surface with a curvature. (*Id.*, col. 3, ll. 17-20.)

8. Whitney teaches that glitter is commonly adhered to the surface of, or embedded in, articles such as clothing and toys. (Whitney, col. 1, ll. 42-45.)

9. Yasuda teaches a temperature-sensitive reversibly deformable laminate made from at least two resin layers having different coefficients of thermal expansion. (Yasuda, col. 1, ll. 44-51.) The laminate may have fabric bonded to the outermost resin layer so as to have a soft texture and unique appearance such that it is suitable for doll clothing or other decorative elements. (*Id.*, col. 8, ll. 4-8.) Yasuda discloses a lengthy list of resins that may constitute the resin layers of the laminate. (*Id.*, col. 3, ll. 18-54.) One such resin is styrene-butadiene copolymer resin. (*Id.*, col. 3, ll. 41-42.)

10. Appellants' claim 20 lists butadiene-styrene copolymer in the recited group of thermoplastic elastomers.

11. O'Brian discloses a toy doll designed to be an improvement on the paper doll concept. (O'Brian, col. 1, ll. 15-16.) O'Brian's doll is three-

dimensional, with apparel that is curved so as to snap onto the doll body. (*Id.*, col. 2, l. 52 – col. 3, l. 11; figs. 1-5.) Each article of apparel is “formed out of a single piece of resilient material ... [and] is temporarily deformed and snapped” onto the doll. (*Id.*, col. 4, ll. 57-66.) When snapped into place, the articles are held against the doll so that they cannot move. (*Id.*, col. 3, ll. 12-18.) O’Brian’s preferred material is polyethylene because “it possesses a comparatively high amount of rigidity when curved as described, and yet is capable of sufficient deformation so as to achieve the essential action required for this invention.” (*Id.*, col. 4, ll. 36-43.)

PRINCIPLES OF LAW

The second paragraph of 35 U.S.C. § 112 states:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The primary purpose of this provision is to provide notice to the public of the metes and bounds of the claimed invention. *In re Hammack*, 427 F.2d 1378, 1382 (CCPA 1970). The test for definiteness under 35 U.S.C. § 112, second paragraph, is “whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). During prosecution, the threshold standard of ambiguity for indefiniteness is lower than it might be during litigation of an issued patent. *Ex parte Miyazaki*, 89 USPQ2d 1207, 1212 (BPAI 2008).

The patentability of a claim in product-by-process form is determined based on the product itself, not on the method of making it. *See In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985) (“If the product in a product-by-

process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process.”). Whether a rejection is under 35 U.S.C. § 102 or § 103, when the Appellants’ product and that of the prior art appear to be identical or substantially identical, the burden shifts to the Appellants to provide evidence that the prior art product does not necessarily or inherently possess the relied-upon characteristics of the Appellants’ claimed product. *See In re Fitzgerald*, 619 F.2d 67, 70 (CCPA 1980).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting 35 U.S.C. § 103). In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *KSR Int’l Co.*, 550 U.S. at 415, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Court pointed out that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss* [*v. Greenwood*], 11 How. 248 [(1851)].” *KSR Int’l Co.*, 550 U.S. at 415 (citing *Graham*, 383 U.S. at 12). The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar

devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 417. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (citations omitted).

For evidence of secondary considerations to be accorded substantial weight, Appellants must establish a nexus between the evidence and the merits of the claimed invention. *See In re GPAC*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). To establish commercial success, Appellants must present “hard evidence” to support a finding of commercial success and must show that the commercial success is a “direct result of the unique characteristics of the claimed invention – as opposed to other economic and commercial factors unrelated to the quality of the [claimed] subject matter.” *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996).

An affidavit or declaration fails in its purpose if it recites conclusions and few facts to buttress those conclusions. *See In re Brandstadter*, 484 F.2d 1395, 1406 (CCPA 1973).

ANALYSIS

Rejection No. 1: The Rejection of Claims 20-23, 25-26, and 28-51 Under 35 U.S.C. § 112, Second Paragraph, as Being Indefinite

We agree with the Examiner's conclusion that the claims are indefinite because Appellants have not clearly and precisely set out the metes and bounds of the claimed subject matter. Neither the claims nor Appellants' Specification identifies a workable objective standard for determining whether a garment fits over a doll "in a life-like way" or is designed to be donned "in a life-like way." See *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350 (Fed. Cir. 2005) ("Some objective standard must be provided in order to allow the public to determine the scope of the claimed invention.").

Independent claims 21 and 22 recite a "garment having a molded shape to fit over, in a life-like way, external surfaces of at least a portion of a doll." Appellants' Specification explains that the flexibility and elasticity of the recited garment provides a high degree of realism as compared to prior art garments, which appeared bulky. (Spec. 1, ll. 9-15; *id.* at 3, ll. 12-16.) This realism can be enhanced by decorating the garment or adding details such as belts, buttons, and collars. (*Id.* at 3, ll. 16-19.) Thus, when read in light of the Specification, the language of claims 21 and 22 reciting a garment that is molded to fit over a doll in a life-like way can be understood to refer to the appearance of the garment on the doll. This claimed "life-like way" is directed to a realistic appearance, suggesting an ambiguous, subjective standard. See *Datamize*, 417 F.3d at 1350 ("A purely subjective construction of 'aesthetically pleasing' would not notify the public of the patentee's right to exclude since the meaning of the claim language would

depend on the unpredictable vagaries of any one person's opinion of the aesthetics of interface screens.”).

The recitation of a garment that is molded to fit over a doll in a life-like way can also be interpreted as referring to how the garment is placed on the doll. The Specification explains that “[d]ue to their elasticity, the garments can be fitted in a life-like way, i.e., jackets are donned ‘arms first’ and dresses, trousers and skirts are stepped into.” (Spec. 3, ll. 29-31.) However, the Specification indicates that the subject matter is not limited to clothing items for human dolls. The Specification states that the word “doll” encompasses non-human as well as human figures. (*Id.* at 4.) The term “garment” is defined as including “any flexible article which can be fitted to the external surface of a doll, including second skins, outfits resembling other animals or creatures and moulded surfaces resembling rock, flames, bones or the like.” (*Id.*) Thus, the claims encompass non-clothing items capable of being donned by a non-human doll in “a life-like way.” Appellants have not provided adequate notice to the public as to the metes and bounds of such a claimed invention.

We conclude that a person of ordinary skill in the art would not be able to discern whether, for example, a suit of flames on a lion doll fits over the lion in “a life-like way” or is molded so as to be donned by the lion in “a life-like way.” Because one of ordinary skill in the art would not understand what is claimed when the claim is read in light of the Specification, claims 21 and 22 were properly rejected as indefinite.

Independent claim 38 recites a “garment which is molded to be removed, dressed and refitted again over external surfaces of the doll in a life-like way.” Independent claim 47 similarly recites a “garment which is

adapted to be dressed, fitted and be removed from a doll in a life-like way.” Thus, claims 38 and 47 encompass at least a garment that is donned in a life-like way. For the reasons discussed above in the context of the similar interpretation of independent claims 21 and 22, independent claims 38 and 47 are also indefinite.

Appellants, specifically referring to claim 38, argue that the person of ordinary skill in the art would understand that the phrase “in a life-like way,” when read in light of the claims, the Specification and drawings, means “that the garments and playsets of the rejected claims are donned or ‘put on’ to a doll in the same manner that a human being ordinarily dons or puts on a correspondingly similar piece of real clothing.” (App. Br. 7-8.) However, this argument is not commensurate with either the language of claim 38 or the Specification’s description of the invention. The language of claim 38 does not include either “human” or “clothing,” but rather recites a “doll’s garment.” As discussed above, the Specification indicates that the phrase “doll’s garment” encompasses much more than articles simulating human clothing.

Appellants also argue that, if the language were truly indefinite, then the Examiner should have made the rejection sooner during prosecution, and therefore “the rejection is both baseless and untimely.” (App. Br. 7.) Appellants state that their “point is merely that for efficiency of office operations and fairness to Applicants, this issue should have been raised long, long ago.” (*Id.*) However, Appellants point to no rule that forbids the Examiner’s actions. (*Cf. id.* (Appellants agreeing that the rules do not prevent the Examiner from making a rejection after the filing of a previous Appeal Brief.)) And, Appellants’ argument is directed to a procedural

matter, which is not an issue within the jurisdiction of the Board. *See In re Mindick*, 371 F.2d 892, 894 (CCPA 1967).

Appellants have not shown that the Examiner erred in rejecting independent claims 21, 22, 38, and 47 as indefinite. Appellants argue all of the rejected claims as a group (specifically mentioning only independent claim 38), and do not argue that the recited aspects of any dependent claims would render the claimed subject matter definite. (App. Br. 7-8.) Accordingly, Appellants have failed to show that the Examiner erred in rejecting claims 20-23, 25-26, and 28-51.

Rejection No. 2: The Rejection of Claims 21-23, 25, 28, and 30-34 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Gross and Kramer

Appellants argue the rejected claims as a group. (App. Br. 21-22.) We select claim 21 as the representative claim, and claims 22, 23, 25, 28, and 30-34 stand or fall with claim 21. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

Gross discloses a flexible, elastomeric jumpsuit for an articulated doll. (Facts 1-3.) Gross's suit is donned as a human would dress (Fact 3), and therefore fits over the doll "in a life-like way," even under Appellants' narrow construction of that phrase (App. Br. 8). Kramer discloses flat doll clothing made from flexible, polymer plastic with a thickness that overlaps the claimed range of 1 to 3 mm. (Fact 5.) Kramer suggests that the selection of the material thickness is a design choice within the skill of the ordinary artisan, and is based upon such factors as the manual dexterity of the child playing with the toy and the level of abuse that the material is expected to encounter. (See Fact 6.) The modification of Gross's jumpsuit material so as to have the claimed wall thickness is merely a variation, prompted by design incentives, of a known work to obtain predictable

results. See *KSR Int'l Co.*, 550 U.S. at 417. Accordingly, we determine that claims 21, 22, 23, 25, 28, and 30-34 are prima facie obvious over Gross and Kramer.

Appellants assert that they have already discussed, earlier in their brief, “the complete inapplicability of both Gross and Kramer when taken alone.” (App. Br. 22.) However, “[n]on-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.” *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)).

Appellants suggest that Gross discloses only an elastic skin that is not removable and does not cover articulated joints. (App. Br. 14-15, 17.) Appellants’ characterization of Gross’s disclosure ignores the teaching of a removable jumpsuit for a doll with movable limbs. (See Facts 1, 3.)

Appellants also assert that, in Gross, “[t]here is no discussion of injection molding.” (App. Br. 14.) As the Examiner noted (Ans. 5), Appellants’ “injection molded thermoplastic elastomer doll’s garment” is a product-by-process limitation. The patentability of such a limitation is determined based on the product itself, not the method of making it. *In re Thorpe*, 777 F.2d at 697. Gross’s jumpsuit appears to be at least substantially the same as Appellants’ injection molded garment. (Fact 4.) Appellants have not offered any persuasive argument or evidence that the process of injection molding results in a structural distinction that might overcome the prior art.

Appellants further argue that there is no incentive to combine the references, and that there is no teaching or suggestion of the suitability of

Kramer's "planar pieces" because they are not intended to be wrapped around or fitted over a doll. (App. Br. 22.) However, the Supreme Court has rejected the rigid requirement of a teaching, suggestion or motivation to combine known elements in order to show obviousness. *KSR Int'l Co.*, 550 U.S. at 418-19. The Court noted that an obviousness analysis "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* at 418. Kramer is relied on for its teaching of a material thickness, whereas Gross is cited for the teaching of a flexible and elastic garment. We are not persuaded that a person of ordinary skill, who is also a person of ordinary creativity, would fail to use the claimed material thickness simply because Kramer's material is planar. *See id.* at 421.

Appellants assert that this is a "new rejection" that "should have been issued long, long ago," and is "untimely and unfair to the Appellants." (App. Br. 21-22.) These assertions pertain to a procedural matter. Procedural matters do not fall within the jurisdiction of the Board. *See In re Mindick*, 371 F.2d at 894.

Rejection No. 3: The Rejection of Claim 26 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Gross, Kramer, and Whitney

Claim 26 depends directly from claim 21 and adds the requirement of a finish selected from the group consisting of paint, varnish, and glitter. Appellants contend that they have already established that one of ordinary skill in the art would not combine Gross and Kramer, and that Whitney does not provide additional teachings or suggestions that would lead to the claimed subject matter. (App. Br. 22-23.) As discussed *supra*, there exists a

rational reason to combine Gross and Kramer so as to arrive at the subject matter of independent claim 21. Whitney teaches that glitter is commonly applied to clothing and toys, thereby teaching the additional subject matter recited in dependent claim 26. (Fact 8.) Accordingly, the subject matter of claim 26 is prima facie obvious over Gross, Kramer, and Whitney.

Rejection No. 4: The Rejection of Claims 20, 29, and 35-37 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Gross, Kramer, and Yasuda

Dependent claims 20 and 35 specify that the recited thermoplastic elastomer is selected from a group of listed materials, including several that contain styrene. Claims 29 and 36-37 depend from either claim 20 or claim 35, and thus also require one of the listed materials. The Examiner found that Yasuda discloses using a thermoplastic elastomer containing styrene to make doll clothes. (Ans. 6; *see also* Facts 9, 10.) Appellants do not specifically contest this finding. (*See* App. Br. 16-17, 20-21, 23.) Rather, Appellants argue that Yasuda's layers are laminated with other films to form a resin molded article, and question whether "the laminate (not the layers) is elastic." (*Id.* at 20.) Appellants also argue that Yasuda fails to disclose that the laminates have application to dolls having articulated limbs. (*Id.*) Appellants are incorrectly focusing on Yasuda's final product (the laminate) rather than what the reference reasonably teaches to one of ordinary skill in the art. *See KSR Int'l Co.*, 550 U.S. at 420. Yasuda teaches that the layer material is known in the art, and that it has application in the doll clothing art. (*See* Fact 9.) The ordinary artisan would not ignore the possibility of utilizing Yasuda's material in doll clothing, notwithstanding that Yasuda ultimately uses that material in an arguably inelastic laminate.

Appellants also assert that they have already established that one skilled in the art would not combine Gross and Kramer. (App. Br. 23.) For the reasons set forth *supra*, we disagree. Appellants further argue that one would not combine Yasuda with Gross and Kramer because Yasuda is “completely different” from those references. (*Id.*) Those three references all pertain to doll clothing (Facts 1, 5, 9), and Appellants have not persuaded us that the references are so different that the ordinary artisan would fail to recognize the pertinent teachings therein.

Appellants have not shown error in the Examiner’s determination that the subject matter of claims 20, 29, and 35-37 is *prima facie* obvious over Gross, Kramer, and Yasuda.

Rejection No. 5: The Rejection of Claims 38-51 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Gross, Kramer, and Yasuda

Like the preceding rejection, the Examiner rejected claims 38-51 as obvious over Gross, Kramer, and Yasuda. (Ans. 6.) Appellants simply assert that they have already established that one of ordinary skill would not combine Gross and Kramer, and that “Yasuda fails to provide any additional teachings to Gross or Kramer that would cure the deficiencies set forth above with respect to Kramer and Gross.” (App. Br. 23-24.) As discussed *supra*, a rational reason exists as to why one would combine Gross and Kramer. Therefore, there are no deficiencies in that regard for Yasuda to cure. Accordingly, Appellants have not shown that the Examiner erred in determining that the subject matter of claims 38-51 is *prima facie* obvious over Gross, Kramer, and Yasuda.

Rejection No. 6: The Rejection of Claims 21-23, 25, 28, and 30-34 Under 35 U.S.C. § 103(a) as Being Unpatentable Over O’Brian, Kramer, and Either Gross or Wion

Appellants argue that the Examiner erred in rejecting claims 21-23, 25, 28, and 30-34 as obvious over O’Brian, Kramer, and either Gross or Wion because one would “have utterly no incentive or motivation to combine O’Brian with Kramer.” (App. Br. 12; *see also id.* at 13.) Appellants assert that “[O’Brian’s] ‘snapping’ action is a totally different mechanism to achieve positioning of the clothing relative to the doll or a doll-like shape as compared to Kramer, which relies on surface tension supplied by the presence of water.” (*Id.*) The Examiner reasoned that it would have been obvious to modify O’Brian’s material “for aesthetic reasons and to provide more flexibility.” (Ans. 18.)

We find the Examiner’s proffered reason for modifying O’Brian deficient in this case. The Examiner does not identify the “aesthetic reasons” that would lead one to combine O’Brian and Kramer. (*See id.*) Also, the Examiner has not adequately explained why a person of ordinary skill would desire to make O’Brian’s garments more flexible. O’Brian’s invention relies on the relative rigidity of the material to allow the garments to snap onto the doll body and to be retained thereon. (Fact 11.) It is not reasonable to conclude that one would consider using a flexible material such as Kramer’s in garments that require rigidity. In this rejection, the Examiner relies on Gross and Wion only for teaching of an articulated doll and a playset (Ans. 8), which does not cure the deficiency of the reasoning to combine O’Brian and Kramer. As such, we do not sustain the rejection of claims 21-23, 25, 28, and 30-34 as unpatentable over O’Brian, Kramer, and either Gross or Wion.

Rejection No. 7: The Rejection of Claim 26 Under 35 U.S.C. § 103(a) as Being Unpatentable Over O'Brian, Kramer, and Either Gross or Wion, and Further in View of Whitney

Claim 26 depends from claim 21. As discussed *supra*, we do not agree with the Examiner's conclusion that one of ordinary skill would combine O'Brian, Kramer, and either Gross or Wion to arrive at the subject matter of claim 21. The Examiner cites Whitney for the disclosure of the application of glitter to articles such as clothing, and reasons that one would apply glitter to the modified O'Brian garment to enhance the visual appearance. (Ans. 8-9.) The Examiner does not, however, suggest that Whitney cures the lack of a reason to first modify O'Brian. (*See id.* at 9.) We do not sustain this Rejection No. 7.

Rejection No. 8: The Rejection of Claims 20, 29, and 35-37 Under 35 U.S.C. § 103(a) as Being Unpatentable Over O'Brian, Kramer, and Either Gross or Wion, and Further in View of Yasuda

Claims 20, 29, and 35-37 depend ultimately from claim 21. We have not sustained the Examiner's rejection of claim 21 based on the combination of O'Brian, Kramer, and either Gross or Wion. *See supra*. The Examiner reasons that one would add Yasuda's styrene-containing thermoplastic elastomer to the combination "in order to give the device more flexibility." (Ans. 9, 20.) As with Rejection No. 6 above, this reasoning lacks a rational underpinning. O'Brian's clothing relies on the material's relatively high amount of rigidity so as to snap onto the doll. (*See* Fact 11.) It does not follow that one of ordinary skill in the art would be led to modify O'Brian's clothing so as to make it more flexible, thereby removing the required

rigidity. We do not sustain the rejection of claims 20, 29, and 35-37 as obvious over the combination of O'Brian et al.

Rejection No. 9: The Rejection of Claims 38-51 Under 35 U.S.C. § 103(a) as Being Unpatentable Over O'Brian, Kramer, Yasuda, and Either Gross or Wion

The basis for this rejection is substantially the same as for the immediately preceding rejection (Rejection No. 8), and is applied to claims 38-51. (See Ans. 9-10.) The Examiner similarly reasons that one would further modify O'Brian's device "in order to give the device more flexibility." (*Id.* at 9.) As in the context of the previous rejections, this rationale is inadequate to support a conclusion of obviousness. In this rejection, the Examiner cites Gross and Wion only for the teaching of an articulated doll and a playset (*id.* at 9-10), which does not cure the inadequacies of the reasoning to modify O'Brian. Accordingly, we do not sustain the rejection of claims 38-51 as unpatentable over O'Brian, Kramer, Yasuda and either Gross or Wion.

Rejection No. 10: The Rejection of Claims 21-23, 25-26, 28, and 30-34 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Kramer, O'Brian, and Either Gross or Wion

This ground of rejection is the same as Rejection No. 6 with the addition of claim 26 and with the order of the primary and secondary references reversed. The Examiner reasons that one would use the teaching of O'Brian's material "with the doll's garment of Kramer for aesthetic reasons and to provide more flexibility." (Ans. 11.) The Examiner does not identify the aesthetic reasons that would prompt the modification. And the reasoning directed to flexibility is not rational. Kramer's material is flexible

and elastic. (Facts 5, 7.) O'Brian's material is resilient yet rigid. (Fact 11.) It seems that modifying Kramer by the teachings of O'Brian would result in a less, not more, flexible garment. In this rejection, the Examiner does not rely on Gross or Wion to cure the deficiencies of the reasoning to combine Kramer and O'Brian. (*See* Ans. 11.) Accordingly, we do not sustain this rejection.

Rejection No. 11: The Rejection of Claims 20, 29 and 35-37 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Kramer, O'Brian, and Either Gross or Wion, and Further in View of Yasuda

This ground of rejection is the same as Rejection No. 8 with the order of the primary and secondary references reversed. The Examiner reasons that one would make the device of Kramer as modified by O'Brian out of Yasuda's styrene-containing elastomer in order to give the device more flexibility. (Ans. 12.) This logic has some appeal. However, as with the rejections discussed *supra*, the Examiner has not set forth a rational reason as to why one would first modify Kramer's flexible garment with O'Brian's relatively rigid material. (*See* Ans. 12.) As such, we are constrained to reverse the rejection of claims 20, 29 and 35-37 as obvious over Kramer, O'Brian, and either Gross or Wion, and further in view of Yasuda.

Rejection No. 12: The Rejection of Claims 38-51 Under 35 U.S.C. § 103 as Being Unpatentable Over Kramer, O'Brian, Yasuda, and Either Gross or Wion

This ground of rejection is the same as Rejection No. 9 with the order of the primary and secondary references reversed. The Examiner reiterates the reasoning that one would use the teaching of O'Brian's material "with the doll's garment of Kramer for aesthetic reasons and to provide more

flexibility.” (Ans. 13.) We have found this reasoning to be inadequate to support the Examiner’s proposed combination, *supra*, and thus we do not sustain this rejection.

Secondary Considerations

For the reasons discussed *supra*, we have determined that all of the claims on appeal are prima facie obvious over the combinations based primarily on Gross and Kramer (Rejections Nos. 2-5). However, evidence of secondary considerations, such as that presented by the Appellants, must be considered in route to a determination of obviousness/nonobviousness under 35 U.S.C. § 103. Accordingly, we consider anew the issue of obviousness under 35 U.S.C. § 103, carefully evaluating and weighing both the evidence relied upon by the Examiner and the objective evidence of non-obviousness provided by Appellants. For evidence of secondary considerations to be accorded substantial weight, Appellants must establish a nexus between the evidence and the claimed inventions – which, in this case, are a doll garment (*e.g.*, claim 21) and a play set comprising a doll and a garment (*e.g.*, claim 33).

Appellants have submitted the declaration of Mr. Casey William Norman as evidence of secondary indicia of non-obviousness. Mr. Norman is a named-inventor on the application at issue, and is the founder and Managing Director of Genie Toys plc. (Norman Decl. 1.)

Mr. Norman opines that, based on his long experience in the toy industry, that the cited prior art does not render the claims obvious. (*Id.*) This conclusory assertion is of little or no value because Mr. Norman fails to set forth any facts underlying the opinion. Further, an expert’s opinion

regarding the ultimate legal conclusion of obviousness is not controlling. *KSR Int'l Co.*, 550 U.S. at 426-27. Mr. Norman also states that the “[r]ejection of the claims is based on the use of hindsight, not actual teachings or suggestions gleaned from the prior art.” (Norman Decl. 1.) This statement is mere argument, not testimony regarding factual matters, and reflects an overly rigid test for determining obviousness. *See KSR Int'l Co.*, 550 U.S. at 418-19.

We next turn to Mr. Norman’s testimony regarding commercial success. Mr. Norman’s declaration leaves us wondering whether there is any nexus between the claimed subject matter and the purported commercial success. Throughout the declaration, Mr. Norman refers to the “product” and “the subject matter” of the claims in this Application. (Norman Decl. 1-3.) Mr. Norman does not describe this “product” other than to say that it has been sold under the “Fashion Polly” name. (*Id.* at 2.) Mr. Norman does not indicate his understanding of the scope of the claimed “subject matter” other than to refer to “the molded elastic clothes product that is the subject matter of the claims[.]” (*Id.* at 3.) Further, Mr. Norman’s testimony, grounded in an unexpressed understanding of the claimed subject matter, has questionable application to our analysis as the Declaration was executed in 2003 – prior to at least two claim amendments (*see* App. Br. 2-3). Given the lack of detail, we are unable to ascertain the relationship between the commercialized “product” and the subject matter of the claims now on appeal. Similarly, Mr. Norman’s testimony that commercial success resulted from “the inventive features of this invention” (Norman Decl. 1), is entitled to little or no weight where he does not identify those features. Further, Mr. Norman’s opinion as to a purchaser’s reasons for buying the

“product” is insufficient to show a nexus between the sales and the claimed subject matter. *In re Huang*, 100 F.3d at 140.

Appellants provide sales figures for the “product” (Norman Decl. 2), and Mr. Norman declares that Polly Pocket is now the bestselling small doll in the world because of “the molded elastic clothes product that is the subject matter of the claims” (*id.* at 3). However, even if we were to find a sufficient nexus between Appellants’ evidence and the claimed subject matter, Appellants have failed to provide persuasive evidence that the sales figures are indicative of significant commercial success. Appellants do not provide other economic information (such as the magnitude of sales normally expected in the pertinent market) to place the raw sales figures in perspective. *Cf. In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996) (“[E]vidence related solely to the number of units sold provides a very weak showing of commercial success, if any.”). At most, Appellants’ evidence of commercial success is weak.

Mr. Norman also states that the “product” has received an important, “highly sought after” award from Mattel. (Norman Decl. 2-3.) The criteria for the award are not mentioned, so we can not discern any nexus between the award and the merits of the claimed subject matter.

Mr. Norman next declares that “the product is now being copied by other toy manufacturers in an effort to share in the financial success brought about by this product.” (*Id.* at 3.) Mr. Norman does not elaborate on this conclusory assertion of copying or otherwise set forth facts underlying the conclusion. Therefore, Appellants have not provided sufficient information to determine whether the claimed inventions have been copied or whether such action is significant to the obviousness analysis. *See Cable Electric*

Products, Inc. v. Genmark, Inc., 770 F.2d 1015, 1028 (Fed. Cir. 1985) (more than the mere fact of copying is necessary to make that action significant to an obviousness determination), *overruled on other grounds by Midwest Indus., Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356 (Fed. Cir. 1999).

On the totality of the evidence, weighing all evidence of obviousness against all evidence of non-obviousness, we conclude that the evidence of obviousness outweighs that against obviousness. Therefore, the rejections based primarily on the combination of Gross and Kramer (Rejections Nos. 2-5) are sustained.

CONCLUSIONS

We conclude that the Appellants have failed to show that the Examiner erred in concluding that one of ordinary skill would not understand the scope of the subject matter of claims 20-23, 25-26, and 28-51 when the claims are read in light of the Specification. Thus, Rejection No. 1 is sustained.

We also conclude that the Appellants have not shown that the Examiner erred in rejecting: claims 21-23, 25, 28, and 30-34 as obvious over Gross and Kramer; claim 26 as obvious over Gross, Kramer, and Whitney; claims 20, 29, and 35-37 as obvious over Gross, Kramer, and Yasuda; and claims 38-51 as obvious over Gross, Kramer, and Yasuda. Thus, Rejections Nos. 2-5 are sustained.

Lastly, we conclude that Appellants have shown that the Examiner has failed to set forth a rational reason as to why one of ordinary skill in the art would have combined O'Brian and Kramer. Therefore, Appellants have shown that the Examiner erred in rejecting: claims 21-23, 25, 28, and 30-34

as obvious over O'Brian, Kramer, and either Gross or Wion; claim 26 as obvious over O'Brian, Kramer, and either Gross or Wion, and further in view of Whitney; claims 20, 29, and 35-37 as obvious over O'Brian, Kramer, and either Gross or Wion, and further in view of Yasuda; claims 38-51 as obvious over O'Brian, Kramer, Yasuda, and either Gross or Wion; claims 21-23, 25-26, 28, 30-34 as obvious over Kramer, O'Brian, and either Gross or Wion; claims 20, 29 and 35-37 as obvious over Kramer, O'Brian, and either Gross or Wion, and further in view of Yasuda; and claims 38-51 as obvious over Kramer, O'Brian, Yasuda, and either Gross or Wion. Thus, Rejections Nos. 6-12 are reversed.

DECISION

The decision of the Examiner to reject claims 20-23, 25, 26, and 28-51 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

LV:

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